

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		1248-0891PUS1	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number	Filed	
	10/589,024	August 10, 2006	
	First Named Inventor		
	Shinichi NISHIDA		
	Art Unit	Examiner	
	2629	S. KUMAR	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/>	applicant/inventor.	<i>Robert Down</i> #48222 Signature <i>Robert Down</i>	
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Charles Gorenstein Typed or printed name	
<input checked="" type="checkbox"/>	attorney or agent of record. Registration number 29271	703-205-8000 Telephone number	
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	May 20, 2011 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/>	*Total of _____ forms are submitted.		

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application of:

Shinichi NISHIDA et al.

Application No.: 10/589,024

Confirmation No.: 4142

Filed: August 10, 2006

Art Unit: 2629

For: DISPLAY APPARATUS, WIRELESS
TRANSMITTING AND RECEIVING
SYSTEM, DISPLAY METHOD, DISPLAY
CONTROL PROGRAM, AND RECORDING
MEDIUM

Examiner: S. KUMAR

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In addition to the Notice of Appeal which is being concurrently filed, Applicants respectfully request a Pre-Appeal Brief Conference to consider the issues raised in the Office Action dated March 21, 2011, that finally rejected claims 15, 16, 18, and 20.

Rejection Under 35 U.S.C. § 103

The Examiner has rejected claims 15, 16, 18, and 20 under the provisions of 35 U.S.C. § 103(a) as being unpatentable over U.S. Application Publication 2003/0120742 ("Ohgami") in view of GB 2,343,334 ("Cho"). The Applicants respectfully submit that claims 15, 16, 18, and 20 are patentable over Ohgami and Cho. For a Section 103 rejection to be proper, the prior art reference (or references when combined) must teach or suggest all the claim limitations. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A

patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Thus, if the cited reference fails to teach or suggest one or more elements, then the rejection is improper and must be withdrawn. The Applicants respectfully submit that Ohgami and Cho fail to disclose several claim elements of claims 15, 16, 18, and 20.

The Rejection fails to Consider all claimed elements

As pointed out in M.P.E.P. 2143.03,

"All words in a claim must be considered in judging the patentability of that claim against the prior art." In *re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In *re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants had amended claim 15 to recite a claimed element, in combination with other claimed elements:

"determination means for detecting a level of the received video signal, and determining whether or not the display apparatus is in the poor signal reception state in which normal reception is not carried out"

Other claimed elements include "display means...", "wireless receiving means...", "recognition information signal detection means...", and "display control means..."

The rejection relies on Ohgami for teaching the claimed "display means" (paras. 0053-0099, 0157-0159), "wireless receiving means" (paras. 0053-0099), and "recognition information signal detection means," (paras. 0053-0099, 0157-0159). The rejection admits that Ohgami does not teach the claimed "display control means," but does not indicate whether or not Ohgami teaches the claimed "determination means..." Applicants presume that the rejection implies that Ohgami does not teach the claimed "determination means," by the statement that:

"Cho teaches display control means and determination means for, when the video signal is not normally received, causing the display means to display one of a plurality of poor reception information that are based on

the display information, the poor reception information of which the display control means causes a display differs according to a result of the detection carried out by the detection means on page 3, line 22 to page 9, line 30 (where the poor reception information is displayed as a bar graph).”

Applicants submit that the rejection does not consider the claimed “determination means for detecting a level of the received video signal, and determining whether or not the display apparatus is in the poor signal reception state in which normal reception is not carried out.”

In addition, the claimed “display control means” not only outputs a signal causing the display means to stop displaying of the video signal...according to the signal detected by the recognition information signal detection means, but also in accordance with signals transmitted from the determination means indicating that the display apparatus is in the poor signal reception state.

Applicants submits that the rejection does not consider all words in the claimed “display control means...” as recited in claim 15.

At least for these reasons, Applicants submit that the rejection is improper and must be withdrawn.

Ohgami and Cho fail to teach features recited in claims as a whole

Claim 15 recites a display apparatus comprising a combination of elements, including “wireless receiving means,” “determination means,” “recognition information signal detection means,” and “display control means.” Further according to claim 15, the “display control means” outputs a signal...in accordance with the recognition information signal detected by the “recognition information signal detection means” and signals transmitted from the “determination means.”

This claimed structure is shown in Fig. 1, in which “determination means” 32 and “recognition information detecting means” 33 have respective inputs to “display control means” 31.

The rejection relies on Ohgami for teaching the claimed “recognition information signal detection means,” but relies on Cho for teaching the claimed “display control means,” and presumably for teaching the claimed “determination means.”

At the outset, Applicants submit that reasoning in the rejection that Cho teaches the claimed "display control means," is in error because the claimed "display control means" requires both the recognition information signal detected by the recognition information signal detection means (admitted as being taught by Ohgami) "and" signals transmitted from the "determination means," in order to display information indicating that it is not possible to receive the video signal.

This error in the rejection is more pronounced with respect to claims 18 and 20. In particular, in claim 18, the claimed "second step" of making a determination as to whether or not a recognition information signal...is identical to a predetermined recognition information signal (allegedly taught by Ohgami) requires a result of the "first step" that the video signal is received at a poor signal reception state (allegedly taught by Cho). Subsequently, Applicants submit that it is not possible for Ohgami and Cho to teach the claimed "first step," "second step," and "third step," as they are not independent steps, and because the "third step" (allegedly taught by Cho) recites that displaying a message that it is not possible to receive the video signal is made "in accordance with a result of the determination made in the "second step" (allegedly taught by Ohgami). This error applies as well to comparable steps recited in claim 20.

To treat the claim otherwise, is to treat each claimed element independently.

For at least these reasons, Applicants submit that the rejection is improper and must be withdrawn.

Dated: May 20, 2011

Respectfully submitted,

By Robert Deans #48222
Charles Gorenstein *Robert Deans*
Registration No.: 29271
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road, Suite 100 East
P.O. Box 747
Falls Church, VA 22040-0747
703-205-8000